

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 10/19/07 have been fully considered but they are not persuasive. Applicant's arguments do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections. Applicant has set forth no remarks concerning the Jenkins reference. With regards to applicant's remarks concerning the Arnold reference it is noted that the amendments merely add functional language and language directed toward the intended use of the device rather than structurally define between the current invention and that of the prior art. The language "configured for" and "sized to fit" requires only something of the structure that gives it the ability to function in the claimed manner. It is the structure of the device that must differentiate the claimed apparatus from that of the prior art and not the use of which the device is intended to be employed. Applicant has merely attempted to define the size of the annular opening based on a diameter of a magazine tube and has neither positively recited the magazine tube nor positively limited the size of the annular opening in that it is well known that magazine tubes are a wide variety of sizes and applicant has not stated in either the specification nor in the claims that the annular opening is a set size but merely tries to define it by some unknown ambiguous, unclaimed and undefined magazine tube. The devices of Arnold and Jenkin has an annular opening with a diameter less than an outside diameter of a least one magazine tube in the world. It has been held that the recitation that an element is "adapted to" or "configured to" perform a

function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

### ***Drawings***

2. The drawings were received on 10/19/07. These drawings are not acceptable; the figures are not of sufficient quality and too dark to show the details in order to examine the application. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

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the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 28-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 28 recites "the end cap retaining said grommet on said end of the magazine tube", it is not clear to the examiner if applicant is attempting to claim the adaptor in combination with the magazine tube and end cap or is merely stating the intended use of the adaptor in that the claim has not previously positively recited the magazine tube or the end cap but has only recited a sling adapter for use with such items. Or is merely attempting to define the size of the opening based on an object that is outside the scope of the claims in which case applicant is merely stating that the structure has *the ability to* perform such function.

6. Claim 28 further recites "the gun sling" and "the shotgun", it is not clear to the examiner if applicant is attempting to claim the adaptor in combination with the gun sling and shotgun or if applicant merely stating the intended use of the adaptor in that the claim has not previously positively recited the magazine tube or the end cap but has only recited a sling adapter for use with such items.

7. Claims 30 and 36 similarly recite "the external diameter of the magazine tube", the claims have not previously positively recited the magazine tube nor the external diameter of the

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magazine tube. It is not clear to the examiner if applicant is attempting to claim the adaptor in combination with the magazine tube or is merely stating the intended use of the adaptor but has only recited a sling adapter for use with such items. Or is applicant merely attempting to define the size of the opening based on an object that is outside the scope of the claims in which case applicant is merely stating that the structure has *the ability to* perform such function.

8. Claim 34 similarly recites “the gun sling”, it is not clear to the examiner if applicant is attempting to claim the adaptor in combination with the gun sling or if applicant is merely stating the intended use of the adaptor in that the claim has not previously positively recited the magazine tube or the end cap but has only recited a sling adapter for use with such items.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 28-30, 32-36, 38 and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Arnold (US Patent # 5,573,152). Arnold discloses a device comprising a grommet (reference 12) formed of high density polyethylene (i.e. a relatively thin (1/16 of an inch), resiliently elastic material; i.e. plastic) having an annular opening (reference 14) of a size that has the ability to fit around a forend of a magazine tube (Arnold discloses the opening as 15/16 of an inch, which is less than an outside diameter of some known magazine tubes) (it is noted that the terms “sized to fit” is not a structural limitation and furthermore the grommet of Arnold has structure allowing it to perform in the desired manner) and having a size that could be held relative to a magazine

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tube by a stock magazine cap and a sling connector (reference 10) coupled to the grommet, wherein the connector has *the ability to* couple an end of a gun sling to the grommet (i.e. is configured to perform the stated function). The thickness of the grommet (i.e. 1/16 of an inch) would allow the attachment of a stock magazine cap to a magazine tube with the grommet held thereinbetween. The annular opening includes radial scoring (reference 26) to effectively increase the annular opening diameter. Both the grommet and the connector are made of a plastic material, and the connector comprises a plastic ring (Figure 4). The connector is attached to the grommet by a loop of the grommet material (reference 20). It is noted that it has been held that the recitations that an element is “adapted to” (“configured for”, “configured to”, “sized to” and “sized for”) perform a function is not a positive limitation but only requires the ability to achieve a degrees of the stated function. It does not constitute a limitation in any patentable sense as long as the structure of the prior has the ability to achieve to at least some degree the claimed function. *In re Hutchison*, 69 USPQ 138. Furthermore it is noted that the [a)statements of intended use or field of use, b)"adapted to" or "adapted for" clauses, c) "wherein" clauses, or d) "whereby"] clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See *In re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 512 USPQ 235; *In re Otto*, 136 USPQ 458; *Ex parte Masham*, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ 2nd 1647

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Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. *In re Danly*, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

11. Claims 28 and 34 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Jenkin (US Patent # 5,303,859). Jenkin discloses a shotgun sling mounting apparatus comprising a grommet and a sling connector. The grommet formed of a relatively thin, flexible material (it is noted that Jenkin discloses that the grommet can be formed of any suitable material and the term “flexible” is a relative term in that any material has a certain amount of flexibility.

Furthermore the term “relatively thin” is a relative term that is not defined by the claims or the specification and therefore does not patentably distinguish between the current claims and that of the previous art). The grommet *has the ability to* be held directly against a forend of a magazine tube by a stock magazine cap and having an annular opening that has the ability to receive an end of a magazine tube of a shotgun (i.e. configured to and sized to perform the stated functions).

The sling connector having the ability to be attached to the grommet and having the ability to couple an end of a gun sling to the grommet (i.e. configured to perform the stated functions).

The sling connector is made of any suitable material and the sling connector is attached to the grommet by a loop of the grommet material (reference 23).

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. *In re Danly*, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525, 1528.

It has been held that the recitation that an element is “adapted to “ perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 31 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jenkin as applied to claim 1 above. Jenkin discloses the claimed invention except for the specific material for the grommet and sling connector. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use rubber for the grommet and a metal ring for the sling connector, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle (Shelley) Clement whose telephone number is 571.272.6884. The examiner can normally be reached on Monday thru Thursday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on 571.272.6873. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michelle (Shelley) Clement/  
Primary Examiner, Art Unit 3641